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PATENT
Attorney Docket No.: 02307E-151530US

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

On 2-17-05

TOWNSEND and TOWNSEND and CREW LLP

By: Karen Karlin

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

TSIEN, Roger Y., *et al.*

Application No.: 10/057,505

Filed: January 25, 2002

For: TANDEM FLUORESCENT
PROTEIN CONSTRUCTS

Customer No.: 20350

Confirmation No.: 7832

Examiner: ROBINSON, Hope A.

Technology Center/Art Unit: 1653

PETITION UNDER 37 C.F.R. § 1.181(a)
TO WITHDRAW HOLDING OF
ABANDONMENT

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants respectfully petition under 37 C.F.R. § 1.181(a) and MPEP § 711.03 to withdraw the holding of abandonment for the above-referenced patent application.

This petition is accompanied by (i) Exhibit A, a print out of the Image File Wrapper summary for the present patent application from private PAIR, indicating receipt of a response to official action on September 9, 2004, and (ii) Exhibit B, a print out from private PAIR of the response to the Official Action mailed on June 2, 2004, the response being mailed under 37 C.F.R. § 1.8 on September 2, 2004, and stamp-recorded as being received by the

USPTO on September 9, 2004.

02/24/2005 AWONDAF1 00000022 201430 10057505

01 FC:2453 750.00 DA

REMARKS

1. The USPTO asserts that the above-referenced patent application is allegedly abandoned for failure to timely file a proper reply to the Office Action mailed on June 2, 2004. The USPTO alleges that no reply has been received (*see*, Notice of Abandonment mailed on January 11, 2005).
2. The Image File Wrapper for the present patent application retrieved through private PAIR show that the USPTO has acknowledged receipt of (i) Applicants argument or remarks made in an amendment, (ii) a miscellaneous incoming letter, (iii) a Terminal Disclaimer, (iv) amendment, (v) specification and (vi) claims on September 9, 2004 (Exhibit A). The amendment filed in response to the Office Action mailed on June 2, 2004 was mailed under 37 C.F.R. § 1.8 on September 2, 2004, and stamped by OIPE as received by the USPTO on September 9, 2004 (Exhibit B).
3. Under 37 C.F.R. § 1.8(b),
 - (b) In the event that correspondence is considered timely filed by being mailed or transmitted in accordance with paragraph (a) of this section, but not received in the Patent and Trademark Office, and the application is held to be abandoned . . . the correspondence will be considered timely if the party who forwarded such correspondence:
 - (1) Informs the Office of the previous mailing or transmission of the correspondence promptly after becoming aware that the Office has no evidence of receipt of the correspondence;
 - (2) Supplies an additional copy of the previously mailed or transmitted correspondence and certificate; and
 - (3) Includes a statement which attests on a personal knowledge basis or to the satisfaction of the Director to the previous timely mailing or transmission. If the correspondence was sent by facsimile transmission, a copy of the sending unit's report confirming transmission may be used to support this statement.

Here, with regard to (1), Applicants became aware that the response to the Office Action mailed on June 2, 2004 was allegedly not received upon receipt of the Notice of

Abandonment, in January 2005. In fact, PAIR records show that the USPTO received the response to the Office Action mailed on June 2, 2004, the response being entered into PAIR records as received by the USPTO on September 9, 2004. With regard to (2), Applicants are supplying with this petition a copy of the response printed from the PAIR image file wrapper, stamped received by the USPTO on September 9, 2004 (Exhibit B). With regard to (3), the Transmittal Sheet, the Amendment in Response to Office Action, and the Terminal Disclaimer each certify under 37 C.F.R. § 1.8 that they were mailed on September 2, 2004, as attested by Karen LePari, the signatory.

4. Accordingly, Applicants submit that the holding of abandonment is in error, because an amendment in response to the Official Action mailed on June 2, 2004 was mailed under 37 C.F.R. § 1.8 on September 2, 2004 and acknowledged as received by the USPTO on September 9, 2004.
5. In view of the foregoing, Applicants hereby respectfully request grant of this petition and withdrawal of the holding of abandonment for the above-referenced patent application.
6. Should the petition to withdraw holding of abandonment not be granted, Applicants petition in the alternative to revive the above-referenced application under 37 C.F.R. § 1.137(b) as unintentionally abandoned for failure to timely respond to the Final Office Action mailed June 2, 2004. Applicants request revival of the application, pursuant to 37 C.F.R. 1.17(m), in the amount of \$750.00 for a small entity from Deposit Account No. 20-1430 of the undersigned.
7. Applicants further state that the entire delay in filing the petition pursuant to 37 C.F.R. § 1.137(b)(3), from the final due date for filing a response to the Final Office Action mailed June 2, 2004, to the filing of a grantable petition, including the delay from the date of discovery of the abandonment of the application, was unintentional. In accordance with the requirements for filing a petition under 37 C.F.R. § 1.137(b)(3), Applicants submit herewith a copy of the Transmittal Sheet, the Amendment in Response to Office Action, and

the Terminal Disclaimer mailed under 37 C.F.R. § 1.8 on September 2, 2004 and stamped received by the USPTO on September 9, 2004 (Exhibit B).

8. Applicant submit this petition with a new transmittal. Please charge any additional fees or credit overpayment to Deposit Account No. 20-1430 of the undersigned.

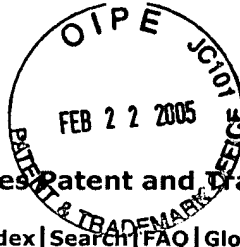
If a telephone conference would expedite consideration of this matter, the Examiner is invited to telephone the undersigned at 925-472-5000.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Annette S. Parent". The signature is fluid and cursive, with the first name "Annette" being more prominent.

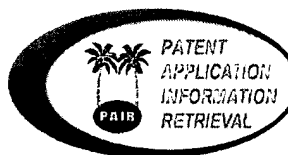
Annette S. Parent
Reg. No. 42,058

TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center, 8th Floor
San Francisco, California 94111-3834
Tel: 925-472-5000
Fax: 415-576-0300
Attachments: Exhibit A
ASP:jlw
60416622 v1



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PATENT APPLICATION INFORMATION RETRIEVAL

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This application is officially maintained in electronic form. To View: Click the desired Document Description. To Download the desired document(s) and click Download.

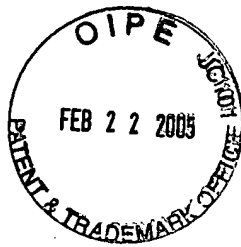
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09/09/2004	<u>Specification</u>	PROSECUTION	1	
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PATENT
ATTORNEY DOCKET NO. REGEN1260-3

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Tsien et al. Art Unit: 1653
Serial No.: 10/057,505 Examiner: Hope A. Robinson
Filed: January 25, 2002
Title: TANDEM FLUORESCENT PROTEIN CONSTRUCTS

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL SHEET

Sir:

Transmitted herewith for the above-identified application please find:

1. Response and Amendment to the Office Action mailed June 2, 2004, including Appendix "A" (12 pages);
2. Terminal Disclaimer (2 pages);
3. Check No. 565743 in the amount of \$110.00
4. Check No. 565894 in the amount of \$290.00; and
5. Return Receipt Postcard.

CERTIFICATION UNDER 37 CFR §1.8

I hereby certify that the documents referred to as enclosed herein are being deposited with the United States Postal Service as first class mail on September 2, 2004, in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Karen LePari

Karen LePari

In re Application of:

Tsien et al.

Application No.: 10/057,505

Filed: January 25, 2002

Page 2

PATENT

Attorney Docket No.: REGEN1260-3

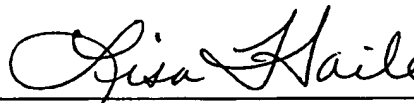
The Fee for this Response is calculated as follows:

For	Claims Remaining After Amendment	Highest Number Previously Paid For	Extra Claims	Small Entity Rate	Large Entity Rate	Calculations
Total Claims	12	22	0	x \$09	x \$18	\$ 0.00
Independent Claims	2	9	0	x \$43	x \$86	\$ 0.00
Multiple Claims	YES	-		\$145	\$290	\$ 290.00
Basic Filing Fee				\$385	\$770	\$ 0.00
					TOTAL FEE	\$290.00

Check No. 565894 is enclosed in the amount of \$290.00 for the multiple dependent claim fee. Check No. 565743 in the amount of \$110.00 is enclosed as payment for the Terminal Disclaimer Fee. The Commissioner is hereby authorized to charge any other fees associated with the filing submitted herewith, or credit any overpayments to Deposit Account No. 50-1355. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

Date: September 2, 2004



Lisa A. Haile, J.D., Ph.D.

Registration No. 38,347

Telephone: (619) 677-1456

Facsimile: (619) 677-1465

GRAY CARY WARE & FREIDENRICH LLP
4365 Executive Drive, Suite 1100
San Diego, California 92121-2189
USPTO Customer Number 28213

PATENT ATTORNEY DOCKET NO.: REGEN1260-3

The Patent and Trademark Office date stamp sets forth the receipt date of:

Applicants: Tsien et al.

Application No.: 10/057,505

Filed: January 25, 2002

Title: TANDEM FLUORESCENT PROTEIN CONSTRUCTS

Art Unit: 1653

Examiner: Hope A. Robinson

- [X] Transmittal (2 pgs, in dup.)
- [X] Response and Amendment to Office Action, including Appendix "A" (12 pgs.)
- [X] Terminal Disclaimer (2 pages)
- [X] Check No. 565743 in the amount of \$110.00
- [X] Check No. 565894 in the amount of \$290.00
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DATE 09/02/04

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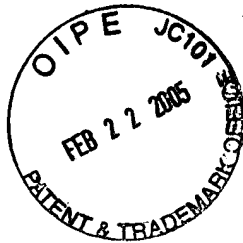
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1653
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PATENT
ATTY. DOCKET NO. REGEN1260-3

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Tsien et al. Art Unit: 1653
Application No.: 10/057,505 Examiner: Hope A. Robinson
Filed: January 25, 2002
Title: TANDEM FLUORESCENT PROTEIN CONSTRUCTS

Mail Stop Amendment
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Sir:

AMENDMENT IN RESPONSE TO OFFICE ACTION

Responsive to the Office Action mailed June 2, 2004, please amend the above-identified application as follows:

Amendments to the Specification begin on page 2 of this paper.

Amendments to the Claims are reflected in the listing of claims which begins on page 3 of this paper.

Remarks/Arguments begin on page 7 of this paper.

09/10/2004 DEMMANU1 00000009 10057505

01 FC:1203

290.00 DP

CERTIFICATION UNDER 37 CFR §1.8

I hereby certify that the documents referred to as enclosed herein are being deposited with the United States Postal Service as first class mail on September 2, 2004, in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Karen LePari
Karen LePari

In re Application of
Tsien et al.
Serial No.: 10/057,505
Filed: January 25, 2002
Page 2

PATENT
Attorney Docket No. REGEN1260-3

Appendix A follows page 11 of the present response and provides amended Table I which replaces current Table I as it appears on page 16 of the specification.

Amendments to the Specification

Please amend the paragraph beginning at page 34, line 21 as follows:

This invention also contemplates tandem constructs possessing a single fluorescent protein moiety that functions as donor or acceptor and a non-protein compound fluorescent moiety that functions as donor or quencher. In one embodiment, the construct comprises a donor fluorescent protein moiety, a non-protein compound acceptor fluorescent moiety and a linker moiety that couples the donor and acceptor moieties. Alternatively, a tandem construct can comprise a non-protein compound donor fluorescent moiety, an acceptor fluorescent protein moiety and a linker moiety that couples the donor and acceptor moieties. Non-protein compound fluorescent donor moieties of particular interest include coumarins and fluoresceins; particular quenchers of interest include fluoresceins, rhodols, rhodamines and azo dyes. Acceptable fluorescent dyes are described, for example, in U.S. application 08/407,544, filed 3/20/95 (now U.S. Patent No. 5,741,657). The donor and acceptor moieties of these constructs are chosen with many of the same considerations for FRET as for tandem fluorescent protein constructs having two fluorescent protein moieties.

Amendments to the Claims

Please amend claims 59, 60 and 61 as indicated in the listing of claims.

Please cancel claims 57, 58 and 76 without prejudice or disclaimer.

The listing of claims will replace all prior versions, and listings of claims in the application:

Listing of Claims:

Claims 57-58. (Canceled)

59. (Currently Amended) The construct of claim 79, 80 or 81 ~~57 or 58~~, wherein the linker moiety comprises between 5 amino acids and 50 amino acids.
60. (Currently Amended) The construct of claim 79, 80 or 81 ~~57 or 58~~, wherein the donor moiety acceptor moiety and the linker moiety are fused in a single amino acid sequence.
61. (Currently Amended) The construct of claim 79, 80 or 81 ~~57 or 58~~, wherein the linker comprises a cleavage recognition site for trypsin, enterokinase, HIV-1 protease, prohormone convertase, interleukin-1b-converting enzyme, adenovirus endopeptidase, cytomegalovirus assemblin, leishmanolysin, b-Secretase for APP, thrombin, renin, angiotensin-converting enzyme, cathepsin D or a kininogenase.

Claims 62-75. (Withdrawn)

76. (Canceled)

77. (Withdrawn)

78. (Withdrawn)

79. (New) A tandem fluorescent protein construct comprising:
- i) a donor fluorescent protein moiety comprising an amino acid sequence substantially identical to SEQ ID NO:2, and which differs from SEQ ID NO:2 by amino acid substitutions selected from the group consisting of:
 - a) Phe64Leu, Ser65Thr, Tyr66Trp, Asn146Ile, Met153Thr, Val163A and Asn212Lys;
 - b) Ser65Gly, Val68Leu, Ser72Ala and Thr203Tyr;
 - c) Tyr66His and Tyr145Phe;
 - d) Tyr66Trp, Asn146Ile, Met153Thr, Val163Ala and Asn212Lys;
 - e) Ser72Ala, Tyr145Phe and Thr203Ile; and
 - f) Ser65Thr, Ser72Ala, Asn149Lys, Met153Thr and Ile167Thr;
 - ii) an acceptor fluorescent protein moiety comprising an amino acid sequence substantially identical to SEQ ID NO:2, and which differs from SEQ ID NO:2 by amino acid substitutions selected from the group consisting of:
 - a) Ser65Gly, Val68Leu, Ser72Ala and Thr203Tyr; and
 - b) Ser65Thr, Ser72Ala, Asn149Lys, Met153Thr and Ile167Thr; and
 - iii) a linker moiety that couples the donor moiety of i) and the acceptor moiety of ii), wherein the linker moiety comprises a protease recognition site.
80. (New) A tandem fluorescent protein construct comprising:
- i) a donor fluorescent protein moiety comprising an amino acid sequence substantially identical to SEQ ID NO:2, and which differs from SEQ ID NO:2 by amino acid substitutions selected from the group consisting of:
 - a) Tyr66His and Tyr145Phe; and
 - b) Tyr66Trp, Asn146Ile, Met153Thr, Val163Ala and Ans212Lys;

- ii) an acceptor fluorescent protein moiety comprising an amino acid sequence substantially identical to SEQ ID NO:2, and which differs from SEQ ID NO:2 by amino acid substitutions selected from the group consisting of:
 - a) Ser65Cys; and
 - b) Ser65Thr; and
- iii) a linker moiety that couples the donor moiety of i) and the acceptor moiety of ii), wherein the linker moiety comprises a protease recognition site.

81. (New) A tandem fluorescent protein construct comprising:

- A) a donor fluorescent protein moiety comprising:
 - i) an amino acid sequence substantially identical to SEQ ID NO:2, and which differs from SEQ ID NO:2 by amino acid substitutions selected from the group consisting of:
 - a) Phe64Leu, Ser65Thr, Tyr66Trp, Asn146Ile, Met153Thr, Val163A and Asn212Lys;
 - b) Ser65Gly, Val68Leu, Ser72Ala and Thr203Tyr;
 - c) Tyr66His and Tyr145Phe;
 - d) Tyr66Trp, Asn146Ile, Met153Thr, Val163Ala and Asn212Lys;
 - e) Ser72Ala, Tyr145Phe and Thr203Ile; and
 - f) Ser65Thr, Ser72Ala, Asn149Lys, Met153Thr and Ile167Thr; or
 - ii) an amino acid sequence substantially identical to SEQ ID NO:2 and comprising a mutation that reduces the hydrophobicity at positions A206, L221 or F223, wherein the mutation attenuates the intermolecular interactions between the donor and acceptor moieties;
- B) an acceptor fluorescent protein moiety comprising:
 - i) an amino acid sequence substantially identical to SEQ ID NO:2, and which differs from SEQ ID NO:2 by amino acid substitutions selected from the group consisting of:

- a) Ser65Gly, Val68Leu, Ser72Ala and Thr203Tyr; and
- b) Ser65Thr, Ser72Ala, Asn149Lys, Met153Thr and Ile167Thr; or
- ii) an amino acid sequence substantially identical to SEQ ID NO:2 and comprising a mutation that reduces the hydrophobicity at positions A206, L221 or F223, wherein the mutation attenuates the intermolecular interactions between the donor and acceptor moieties; and
- C) a linker moiety that couples the donor moiety of A) and the acceptor moiety of B), wherein the linker moiety comprises a protease recognition site.

Remarks/Arguments

Claims 57, 58 and 76 have been canceled. Claims 62-75, 77 and 78 are withdrawn. New claim 79-81 have been added. Claims 59, 60 and 61 have been amended to depend from the new claims. The new claims do not introduce new matter and are fully supported by the specification and claims as originally filed. The new claims are presented to clarify the scope of the claimed inventions and to address issues raised in the pending Office Action.

A new oath/declaration accompanies the present response. In addition, a terminal disclaimer accompanies the present response. Entry of the amendment is respectfully requested. Upon entry of the present amendment, claims 59-61 and 79-81 will be pending and at issue.

I. Rejection Under 35 U.S.C. §112 First Paragraph

Written Description

Claims 57-61 and 76 stand rejected under 35 U.S.C. §112, first paragraph, as allegedly containing subject matter not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of the claimed invention. This rejection is moot with regard to canceled claims 57, 58 and 76. Applicants traverse this rejection as it may apply to the amended claims and new claims.

To advance prosecution, new claims 79-81 no longer recite the “comprising” language objected to by the Office Action. Despite the elimination of this language, and in contrast to the assertion by the Office Action, the written description component of §112 does not require Applicants to “define” all the members of a claimed genus nor must all members of that genus be “biologically functional.” Accordingly, the new claims are presented solely to clarify the scope of the claimed invention and to expedite allowance of the pending claims.

The Office Action also alleges that the specification lacks adequate written description with regard to the “linker.” Applicants note that the “linker” language recited in the new claims is similar to the language appearing in the allowed claims of application Serial No. 08/594,575, or in the issued claims presented in U.S. Patent No. 5,981,200, both of which are related to the

present application. It is not clear why such language succeeds in satisfying the written description requirement for the claims in the parent applications, but fails to do so for the claims presented in their progeny. Applicants maintain that the "linker" language included in the new claims clearly allows persons of ordinary skill in the art to recognize that Applicants were in possession of the claimed invention.

In view of the new claims and in light of the above discussion, Applicants request that the rejection under 35 U.S.C. §112, first paragraph be withdrawn.

Enablement

Claims 57-61 and 76 stand rejected under 35 U.S.C. §112, first paragraph, as allegedly non-enabled. This rejection is moot with regard to canceled claims 57, 58 and 76. Applicants traverse this rejection as it may apply to the amended claims and new claims.

As noted above, new claims 79-81 have been added to expedite allowance of the pending claims. Applicants submit that the language recited in the new claims render the present rejection moot.

The Office Action alleges that the specification is not enabled for "linkers that are fluorescent" nor for linkers that fall outside a range of 5-50 amino acids in length. As previously noted, the "linker" language recited in the new claims is similar to the language appearing in the allowed claims of application Serial No. 08/594,575, or in the issued claims presented in U.S. Patent No. 5,981,200, both of which are related to the present application. The Office Action appears to take the position that, since the specification allegedly fails to enable "fluorescent" linkers, the pending claims should specifically exclude everything that the linker can not be (i.e., "linkers that are not fluorescent"). Alternatively, the Office Action appears to suggest that that Applicants should limit the linker to a specific length (i.e., "linkers that are between 5 and 50 amino acids in length").

Applicants respectfully submit that the written disclosure of the instant application is supplemented by the knowledge held by one of ordinary skill in the art. The skilled artisan is one who is knowledgeable about basic laboratory/research protocols. It is well settled law that

an Applicant need not include in the disclosure information that is well known in the art. Applicants have provided exemplary methodology for designing a linker that is operably integrated in to the claimed tandem fluorescent protein construct. It is well within the capabilities of the skilled artisan, at the time the application was filed, to take such examples and modify the size and/or composition of the linker to obtain a construct of the invention. The skilled artisan can manufacture various linkers that can be used in the claimed construct without undue experimentation because he/she will recognize is unnecessary to test every possible linker composition, or linker length, that can, in theory, be used in the claimed construct. Accordingly, the claimed construct should not be limited to including a linker having the an exemplary composition and/or length set forth in the specification because the skilled artisan can easily determine the optimal linker length for use in the claimed construct.

In view of the new claims and in light of the above discussion, Applicants request that the rejection under 35 U.S.C. §112, first paragraph be withdrawn.

II. Rejection Under 35 U.S.C. §112 Second Paragraph

Claims 57-61 and 76 stand rejected under 35 U.S.C. §112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. This rejection is moot with regard to canceled claims 57, 58 and 76. While Applicants traverse this rejection, Applicants submit that the presentation of new claims 79, 80 and 81, and the amendments to claims 59, 60 and 61, render the rejection moot. Accordingly, Applicants respectfully request that the rejection under 35 U.S.C. §112, second paragraph be withdrawn.

III. Rejection Under Obviousness-Type Double-Patenting

Claims 57-61 and 76 stand rejected under the judicially created doctrine of obviousness-type double patenting as allegedly being unpatentable over claims 1-4, 7-12 and 14 of U.S. Patent No. 5,981,200. Applicant respectfully traverses this rejection and notes that rejection is moot with respect to canceled claims 57, 58 and 76.

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The present application is a continuation of U.S. Serial No. 09/396,003, filed September 13, 1999, which is a continuation of U.S. Serial No. 08/792,553, filed January 31, 1997 (now U.S. Patent No. 5,981,200), which is a continuation-in-part of U.S. Serial No. 08/594,575, filed January 31, 1996. Applicants note that the non-statutory double patenting rejection, whether of the obviousness-type or non-obviousness-type, is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent. Given that the present application claims priority to the filing date of the patent providing the basis for this rejection, the Applicants are clearly not seeking to extend the "right to exclude" based any patent resulting from the present application. Nevertheless, a terminal disclaimer in compliance with 37 CFR 1.321(c) accompanies the present response. Accordingly, Applicants request withdrawal of this rejection.

In view of the foregoing, Applicants respectfully submit that the claims are in condition for allowance. Please apply any charges not covered, or any credits, to Deposit Account 50-1355. The Examiner is invited to contact Applicants' undersigned representative if there are any questions relating to this application.

Respectfully submitted,

Date: September 2, 2004

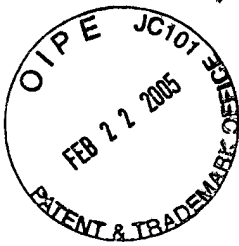


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USPTO Customer Number 28213

Appendix A
TABLE I

<u>Clone</u>	<u>Mutation(s)</u>	<u>Excitation max</u> <u>(nm)</u>	<u>Emission</u> <u>max (nm)</u>	<u>Extinct. Coefficient</u> <u>(M⁻¹cm⁻¹)</u>	<u>Quantum</u> <u>yield</u>
<i>Wild Type</i>	none	395 (475)	508	21,000 (7,150)	0.77
<i>P4</i>	Y66H	383	447	13,500	0.21
<i>P4-3</i>	Y66H; Y145F	381	445	14,000	0.38
<i>W7</i>	Y66W; N146I M153T V163A N212K	433 (453)	475 (501)	18,000 (17,000)	0.67
<i>W2</i>	Y66W; I123V Y145H H148R M153T V163A N212K	432 (453)	480	10,000 (9,600)	0.72
<i>S65T</i>	S65T	489	511	39,200	0.68
<i>P4-1</i>	S65T; M153A K238E	504 (396)	514	14,500 (8,600)	0.53
<i>S65A</i>	S65A	471	504		
<i>S65C</i>	S65C	479	507		
<i>S65L</i>	S65L	484	510		
<i>Y66F</i>	Y66F	360	442		
<i>Y66W</i>	Y66W	458	480		
<i>I0c</i>	S65G; V68L S72A; T203Y	513	527		
<i>W1B</i>	F64L; S65T Y66W; N146I M153T V163A N212K	432 (453)	476 (503)		
<i>Emerald</i>	S65T; S72A N149K M153T I167T	487	508		
<i>Sapphire</i>	S72A; Y145F T203I	395	511		



PATENT
ATTORNEY DOCKET NO. REGEN1260-3

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Tsien et al.	Art Unit:	1653
Serial No.:	10/057,505	Examiner	Hope A. Robinson
Filed:	January 25, 2002		
Title:	TANDEM FLUORESCENT PROTEIN CONSTRUCTS		

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

TERMINAL DISCLAIMER

Sir:

The undersigned, attorney of record for Petitioners, THE REGENTS OF THE STATE OF CALIFORNIA ("The Regents") and AURORA BIOSCIENCES CORPORATION ("Aurora") represents that Petitioners are the Assignees of all interest in Application No. 10/057,505, filed January 25, 2002, entitled TANDEM FLUORESCENT PROTEIN CONSTRUCTS, as evidenced by the Assignments recorded in the United States Patent and Trademark Office on April 23, 1996, at Reel 0859, Frame 4545 (The Regents) and June 18, 1997, at Reel 8591, Frame 0069 (Aurora).

The evidentiary documents referred to herein have been reviewed by the undersigned and it is certified that to the best of the undersigned's knowledge and belief, title is in the Assignee.

09/10/2004 DEMMANU1 00000009 10057505

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CERTIFICATION UNDER 37 CFR §1.8

I hereby certify that the documents referred to as enclosed herein are being deposited with the United States Postal Service as first class mail on September 2, 2004, in an envelope addressed to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

Karen LePari
Karen LePari

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PATENT
Attorney Docket No.: REGEN1260-3

Pursuant to 37 C.F.R. § 1.321(c), the undersigned, on behalf of Petitioners, The Regents and Aurora, disclaims the terminal part of any patent granted on the above-identified Application No. 10/057,505 which would extend beyond the expiration date of U.S. Patent No. 5,981,200. Petitioner hereby agrees that any patent so granted on the above-identified application, No. 10/057,505, shall be enforceable only for and during such period that the legal title to said patent shall be the same as the legal title to U.S. Patent 5,981,200, this Agreement to run with any patent granted on the above-identified application and to be binding upon the grantee, its successor or assigns.

Enclosed is Check No. 565743 in the amount of \$110.00 to cover the Terminal Disclaimer filing fee. The Commissioner is authorized to charge any additional fees or credit any overpayment to Deposit Account No. 50-1355 referencing Attorney Docket No. REGEN1260-3.

Respectfully submitted,

Date: September 2, 2004



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